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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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TYCO INTERNATIONAL 9 ROSZEL ROAD PRINCETON, NJ 08540			EXAMINER KEE, FANNIE C	
			ART UNIT	PAPER NUMBER
			3679	
			MAIL DATE	DELIVERY MODE
			11/28/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/574,811

**Applicant(s)**

MIESZELEWICZ, GLENEK

**Examiner**

Fannie Kee

**Art Unit**

3679

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 April 2006.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 and 12-20 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-9 and 12-20 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 05 April 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. It appears that Applicant attempted to submit an Information Disclosure Statement ("IDS") on 5/14/08. However, an IDS form (Form 1449) was not filed at that time. The only thing filed was an IDS letter. Applicant needs to re-submit the Form 1449 IDS form.

### ***Drawings***

2. The drawings are objected to because in Figures 1-2, there is extraneous written matter. The extraneous written matter should be designated by reference element numbers on the drawings whereas the description of those elements should be in the specification.
3. The drawings are objected to because in Figure 1, separated elements within the same figure should either be connected by dotted lines or by brackets to designate all of the elements as one complete figure. Otherwise, each separate element should have a separate figure number designation.
4. The drawings are also objected to because in Figures 1-2, the cross-hatching pattern for the sealing ring "8" is incorrect.
5. The drawings are also objected to because in Figures 1-2, the cross-hatching pattern for the polyethylene coating "2" and the internal surfaces "12" are incorrect.

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character “15” has been used to designate both a joint (page 4, line 7) and an axial location (page 8, line 32).

7. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### *Specification*

8. The abstract of the disclosure is objected to because of the use of legal phraseology, i.e., “[t]here is disclosed” in line 1.

Correction is required. See MPEP § 608.01(b).

9. The disclosure is objected to because of the following informalities:
- Page 1, line 26 - replace the word "coming" with --becoming--.
  - Page 4, line 7 and page 8, line 32 - reference character "15" has been used to designate both a joint and an axial location.
  - Page 7, line 20 - replace "(2)" with --(4)--.
- Correction is required.

***Claim Objections***

10. Claims 1 and 4 are objected to because Claims 1 and 4 need to be re-written according to 37 CFR 1.75(i) - where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation.

11. Claim 4 is objected to because of the following informalities: use either the word "the" or the word "said" before the word "lip" in line 7 - both words are not necessary.

Correction is required.

12. Claim 5 is objected to because of the following informalities: use either the word "the" or the word "said" before the words "heat sink member" in line 4 - both words are not necessary.

Correction is required.

13. Claim 8 is objected to because of the following informalities: replace the word "claim" with --claims-- in line 1.

Correction is required.

14. Claim 9 is objected to because of the following informalities: replace the word "claim" with --claims-- in line 3.

Correction is required.

15. Claims 15-20 are objected to because of the following informalities: replace the word "claim" with --claims-- in line 2.

Correction is required.

***Claim Rejections - 35 USC § 101***

16. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

17. Claims 9 and 15-20 are rejected under 35 U.S.C. 101 because they improperly embrace both product or machine and process. The language of 35 U.S.C. 101 sets forth statutory classes of invention in alternative only. See *Ex parte Lytell*, 17 USPQ2D 1549.

***Claim Rejections - 35 USC § 112***

18. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

19. Claims 1-9 and 12-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites "a lip is provided which provides a welding location remote from the sealing ring with the coating on the end of the socket *if necessary* having been removed to facilitate welding". What does Applicant mean by "if necessary"? Does Applicant mean that it is not necessary to remove the coating at the end of the socket? What determines the metes and bounds of "if necessary"? To which end of the socket is Applicant referring? Applicant has not defined any ends of the socket. Examiner is interpreting that it is not necessary to have the coating removed from either end of the socket in order to meet this limitation.

Claim 1 also recites the limitation "the end of the socket" in 7. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 recites the limitation "the extreme end of the socket" in 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 3 also recites “the pipe having the socket is coated both internally and externally with the material to prevent corrosion except at the extreme end of the socket where no coating has been provided or has been removed”. How can claim 3 have the limitation that “no coating has been provided” if in claim 1 from which claim 3 depends, the pipe having the socket has been coated internally and or externally with a material to prevent corrosion? A coating was present in the previous claim from which this claim depends. Examiner is interpreting that Applicant is trying to say that the coating was removed from the extreme end of the socket.

Claim 4 recites “said method including forming a groove in the socket to provide a seat for a sealing ring and also forming a lip in the socket to enable said socket to overlap a heat sink member on the spigot *and in contact with the metal of said spigot*, and wherein the said lip is welded to said heat sink member”. It is not clear what Applicant means by “and in contact with the metal of said spigot”. What is in contact with the metal of the spigot? Is Applicant referring to the heat sink member or the lip or the socket itself? It is not clear what element Applicant is referring to. Examiner is interpreting that Applicant is referring to the heat sink member having contact with the metal of the spigot.

Claim 12 recites the limitation “the extreme end of the socket” in 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 12 also recites “the pipe having the socket is coated both internally and externally with the material to prevent corrosion except at the extreme end of the socket where no coating



has been provided or has been removed”. How can claim 12 have the limitation that “no coating has been provided” if in claims 1 and 2 from which claim 12 depends, the pipe having the socket has been coated internally and or externally with a material to prevent corrosion? A coating was present in the previous claim from which this claim depends. Examiner is interpreting that Applicant is trying to say that the coating was removed from the extreme end of the socket.

Claims 9 and 15-20 are ambiguously constructed and indeterminate in scope because they purport to claim both an apparatus and method of using or practicing the apparatus in a single claim.

***Claim Rejections - 35 USC § 102***

20. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

21. Claims 1-6, 8, 12, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Stromsoe U.S. Patent No. 2,273,154.

With regard to claim 1, Stromsoe discloses a pipe joint between two metallic pipes which have been internally and/or externally coated with a material to prevent corrosion, said joint including a spigot and a socket, said socket (1) having an internal circumferential groove (area at 3) that provides a seating for an elastomeric sealing ring, and forwardly of which groove a lip

(11) is provided which provides a welding location remote from the sealing ring with the coating on the end of the socket if necessary having been removed to facilitate welding, said spigot (2) having a heat sink member (6) to enable the lip of the socket to be welded to the metal of the spigot.

With regard to claim 2, Stromsoe discloses the heat sink member (6) being a metal band attached to and extending circumferentially around said spigot.

With regard to claim 3, Stromsoe discloses the pipe having the socket (1) being coated both internally and externally with the material to prevent corrosion except at the extreme end of the socket where no coating has been provided or has been removed (see Figure 5), whilst the exterior of the spigot is coated with the material to prevent corrosion except at the location of the heat sink.

With regard to claim 4, Stromsoe discloses a method of forming a pipe joint between the spigot and socket ends of a pair of metallic pipes which have been internally and/or externally coated with a material to prevent corrosion, said method including forming a groove (area at 3) in the socket to provide a seat for a sealing ring and also forming a lip (11) in the socket to enable said socket to overlap a heat sink member (6) on the spigot (2) and in contact with the metal of said spigot, and wherein the said lip is welded to said heat sink member (at 52).

With regard to claim 5, Stromsoe discloses the steps of the formation of the socket end of the pipe at the joint with said groove and said lip, and the spigot end of the associated pipe, including the positioning of the said sink member, being performed off, or at, the site where the joint between the pipes is to be made.

*Note: the location of the steps of formation of the invention of the instant application is not germane to the patentability of the invention. Therefore, this limitation is given little patentable weight.*

With regard to claim 6, Stromsoe discloses the pipes being heated to a predetermined temperature and immersed in a fluidized bed of the material to prevent corrosion off, or at, the site where the joint between the pipes is to be made.

*Note: the location of the steps of formation of the invention of the instant application is not germane to the patentability of the invention. Therefore, this limitation is given little patentable weight.*

With regard to claim 8, Stromsoe discloses the material to prevent corrosion is removed from the lip of the socket and the heat sink member off, or at the site where the joint between the pipes is to be made.

*Note: the location of the steps of formation of the invention of the instant application is not germane to the patentability of the invention. Therefore, this limitation is given little patentable weight.*

With regard to claim 12, Stromsøc discloses the pipe having the socket (1) is coated both internally and externally with the material to prevent corrosion except at the extreme end of the socket where no coating has been provided or has been removed (see Figure 5), whilst the exterior of the spigot is coated with the material to prevent corrosion except at the location of the heat sink.

With regard to claim 13, Stromsøc discloses the pipes being heated to a predetermined temperature and immersed in a fluidized bed of the material to prevent corrosion off, or at, the site where the joint between the pipes is to be made.

*Note: the location of the steps of formation of the invention of the instant application is not germane to the patentability of the invention. Therefore, this limitation is given little patentable weight.*

### ***Claim Rejections - 35 USC § 103***

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stromsøc.

With regard to claims 7 and 14, Stromsoe discloses the claimed invention but does not disclose that prior to immersion in the fluidized bed of the material to prevent corrosion the surfaces which are to be coated are grit blasted.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have grit-blasted the surfaces to be coated by a material to prevent corrosion so that the material being applied to the surfaces would adhere better to the surfaces thereby forming a secure layer of material to resist the effects of corrosion.

### *Conclusion*

24. Hirsh, Press et al, Coddling, III et al, and Mieszelewicz et al are being cited to show other examples of pipe joints in the mechanical art.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fannie Kee whose telephone number is (571) 272-1820. The examiner can normally be reached on 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (571) 272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Aaron M Dunwoody/  
Primary Examiner, Art Unit 3679

/F. K./  
Examiner, Art Unit 3679  
November 23, 2008